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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,730	12/26/2000	Yoshikazu Kobayashi	369252/99	1971
30743	7590	08/15/2005	EXAMINER	
WHITHAM, CURTIS & CHRISTOFFERSON, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON, VA 20190			SCHEIBEL, ROBERT C	
			ART UNIT	PAPER NUMBER
			2666	

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/745,730

Applicant(s)

KOBAYASHI, YOSHIKAZU

Examiner

Robert C. Scheibel

Art Unit

2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2004 and 21 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

- Applicant's Amendment filed 7/21/2005 is acknowledged.
- Claims 1-11 are still pending.
- The finality of the previous rejection is withdrawn; however, this action is made final as described herein.

### ***Response to Arguments***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

In the section titled "Preliminary Matter" on page 5, filed 7/21/2005, applicant has indicated that claims 8-11 (newly added on 12/30/2004) were not addressed in the last office action (dated 5/31/2005). As such, the finality of the office action dated 5/31/2005 has been withdrawn and the present office action has been made final. A new ground of rejection of claims 1-7 was necessitated by amendment in the action of 5/31/2005 and is maintained herein. The rejection of claims 8-11 has been added below.

2. As stated in the previous office action, applicant's arguments, see pages 5-7, filed 12/30/2004, with respect to the rejections of claims 1-7 under 35 U.S.C. 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, new grounds of rejection are made in view of U.S. Patent 6,798,767 to Alexander, et al and U.S. Patent 6,731,625 to Eastep et al.

Art Unit: 2666

3. Applicant's arguments see the section titled "Obviousness Rejection" on pages 5-7, filed 7/21/2005, have been fully considered but they are not persuasive.

Applicant summarizes the rejection of claims 1-7 in the first four paragraphs of the section titled "Obviousness Rejection". Examiner generally agrees with this characterization of the rejection. Applicant then traverses the rejection in the remainder of the section. First, Applicant asserts that Alexander (U.S. Patent 6,798,767) is more removed from Applicant's invention that examiner has realized. Specifically, applicant argues that Alexander does not disclose that a person without knowledge of LAN and IP can simply connect the telephone set to the LAN and the IP address is automatically allocated. Applicant continues this argument by stating that "applicant's invention is not 'DHCP or similar protocol or technique'".

Examiner respectfully disagrees with this argument. First of all, the limitation that a person without knowledge of LAN and IP technology may utilize this invention is not claimed in the independent claims as implied by the Applicant on page 6. Thus, the previous rejection of the independent claims is maintained. The above limitation regarding the invention's use by one without LAN or IP knowledge is claimed in part in claims 8 and 9 and as such is addressed fully below. Briefly, it is well known that DHCP does in fact automatically allocate a user's IP address without any intervention on the user's part (and thus without any knowledge of IP or LAN technology).

Applicant then argues (first paragraph on page 7) that one of ordinary skill in the art would not have had access to the art of Alexander as it was not published at the time of the invention. However, Examiner disagrees; the filing date of the Alexander document is prior to the date of invention and thus is valid prior art as used in the rejection below. 35 U.S.C. 103

Art Unit: 2666

does not require that the prior art document be published prior to the date of invention.

Applicant further argues in the next paragraph that the inventors (Alexander, et al) have above-ordinary skill in the art. Examiner respectfully argues that this document is valid prior art and that the obviousness rejection put forth previously still applies.

### *Claim Objections*

4. Claims 8-11 are objected to because of the following informalities:

- These claims are labeled “Original” and should be corrected to be labeled “Previously Presented”.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims **1-2, 4-5 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,798,767 to Alexander et al.

Regarding claims **1 and 4**, Alexander discloses the limitation of a receiver that receives a message sent via LAN by one of the telephone sets for requesting an IP address be allocated for the requesting telephone set in lines 20-23 of column 9. The receiver is inherently contained in the DHCP server; the server is implicit in the discussion of the use of DHCP. Alexander further

Art Unit: 2666

discloses a control circuit that generates an ID and an extension of the requesting telephone sets set in case the message for requesting the IP address is received in lines 26-29 of column 9. In this case, the case where multiple extensions are assigned is assumed; the first extension discloses the extension of the claims and the other extensions disclose the ID of the claims. Alexander implicitly discloses the IP address allocation circuit that allocates the IP address of the requesting telephone set in lines 20-23 of column 9; in order for the telephony device to get an IP address, one must be allocated. Alexander discloses the limitation of a table that stores an ID, an extension and the IP address in the combination of tables 4A and 4B and as described in lines 28-35 of column 9. Alexander further discloses the limitation of a notifying unit that notifies the requesting telephone sets set of the ID, the extension and the IP address for the requesting telephone set in lines 20-23 and 26-29 of column 9. Alexander further discloses the limitation of claim 4 that one of the telephone sets (telephony device) is provided with a transmitter that transmits via LAN a message for requesting an IP address be allocated for the requesting telephone set to the telephone controller in lines 20-23 of column 9. The transmitter is implicit in that it is required to request the IP address using DHCP.

Alexander does not disclose expressly the limitation that the ID, extension, and the IP address are all stored in a single table. Alexander also does not disclose expressly the limitation (telephone controller) that the DHCP server is collocated with the call manager 26. However, at the time of the invention it would have been obvious to a person of ordinary skill in the art to modify Alexander to locate the DHCP in the call manager 26 and to combine tables 4A and 4B. The motivation for doing so would have been to reduce the overall cost of the system. In case of locating the DHCP server in the call manager, the system would cost less due to the reduction in

Art Unit: 2666

the number of required network elements. In the case of combining the tables, less memory would be required to store the information contained in the tables, as the device names would not have to be duplicated. Therefore, it would have been obvious to modify Alexander for the benefit of cost reduction to obtain the invention as specified in claims 1 and 4.

Regarding claims **2 and 5**, with the parent claims 1 and 4 addressed as above, Alexander discloses in lines 20-25 of column 9 the limitation that wherein the requesting telephone has a user name (MAC address) and when the extension or the user name (it is well known that the MAC address is included in the DHCP request) of the requesting telephone is included in the message for requesting the IP address, and the control circuit generates its the ID for the requesting telephone set based on the extension or the user name (the MAC address and the associated device name is sent to the call manager in a registration message and the ID (the second assigned extension) is generated based on this registration and thus based on the user name.

Regarding claim **7**, with parent claim 4 addressed as above, Alexander discloses the limitation that the telephone controller in case a connection request message is sent from one of the telephone sets, the control circuit acquires an IP address corresponding to ID by retrieving the table using the m included in the connection request message and notifies a telephone set to which the IP address is allocated of call incoming in elements 200-204 of Figure 5.

Regarding claims **8 and 9**, with parent claims 1 and 4 addressed as above, Alexander discloses the limitation that a user who is not required to have knowledge of IP and LAN connects the requesting telephone set to the LAN and the requesting telephone set automatically acquires an ID, an IP address and an extension for the requesting telephone set in lines 20-23 and

Art Unit: 2666

26-29 of column 9. It is well known in the art that DHCP (Dynamic Host Configuration Protocol) is a means of automatically assigning an IP address to a host station from a server station. This requires the user to have no knowledge of IP or LAN technology and can happen without his knowledge. The same is true of the extension and ID as indicated in lines 26-29 of column 9 which indicate the call manager sending the response to the telephony device without indicating that the user is actively involved in this transaction.

Regarding claims **10 and 11**, with parent claims 1 and 4 addressed as above, Alexander discloses the limitation that different user names are assigned to the extension in Figure 4A which shows extension 1002 assigned to user phone2 and phone3.

3. Claims **3 and 6** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,798,767 to Alexander et al in view of U.S. Patent 6,731,625 to Eastep et al.

Alexander discloses the limitations of the parent claims 1 and 4 as discussed above.

Alexander does not disclose expressly the limitation that the ID is composed of the domain name of the telephone controller, the extension and the user name.

Eastep discloses a directory service for allowing a caller to identify the IP address of a called party using a unique identifier (see lines 34-55 of column 83). Eastep discloses the use of an email address as an identifier and also indicates that any format can be used. By modifying one of the extensions assigned by Alexander to be an email address, the limitation of claim 3 that the ID is composed of a domain name, extension and user name is disclosed. Alexander and Eastep are analogous art because they are from same field of endeavor of IP telephony. At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify Alexander to assign an extension which is an email address. The motivation for doing so would



Art Unit: 2666

have been to allow the use of a familiar identifier to uniquely identify the user as implied by Eastep in the passage cited above. Therefore, it would have been obvious to combine Eastep with Alexander for the benefit of a familiar identifier to obtain the invention as specified in claim 7.

### *Conclusion*

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

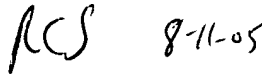
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert C. Scheibel whose telephone number is 571-272-3169. The examiner can normally be reached on Monday and Thursday from 6:30-5:00 Eastern Time.

Art Unit: 2666

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Robert C. Scheibel  
Examiner  
Art Unit 2666

  
DANG TON  
PRIMARY EXAMINER